

REMARKS

Claims 1-36 are pending in the application with Claims 1, 12, 17, 24, 25, 26 and 35 as independent claims. Claims 26-36 are newly added. The Examiner has rejected Claims 1-7, 10-12 and 15-25 under 35 U.S.C. §102(b) as being unpatentable over Philip et al. (WO 0005912) and Claims 8, 9, 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Philip in view of John et al. (GB Pub. No. 2398455).

Philip discloses a method for allocating resources to a terminal in a communication system. The system is arranged to support a first duplexing scheme and a second duplexing scheme. One of the first or second duplexing schemes is allocated to the terminal in response to at least one criteria relating to the spectral use of the system so as to optimize the spectral efficient use of the system by the terminal. (See Abstract).

John discloses a method for downloading data in a second mode while operating in a first mode. (See page 6, line 26-page 7, line 4). John does not disclose the method for setting the mode claimed in the present invention.

Regarding the rejection of independent Claims 1, 12, 17, 24 and 25, it is respectfully submitted that the Examiner has misconstrued Philip and therefore incorrectly rejects the claims. The following arguments are presented for the Examiner's consideration.

The Examiner asserts that Philip discloses each and every feature of independent Claims 1, 12, 17, 24 and 25. It is respectfully submitted that the Examiner is incorrect. The Examiner cites Figures 1 and 8, page 9, line 36-page 10, line 7 as allegedly teaching "a mobile station for, during call setup, transmitting a duplexing mode determination factor to a base station, setting a TDD mode or an FDD mode as a reverse mode set by the base station, and setting up a channel for the set reverse mode and a forward channel to perform communication."

After careful review of Philip, Applicants find no section of Philip disclosing the features of Claim 1. The Examiner correctly noted that Philip discloses "cellular phone determines the communication characteristics that it requires and based on those characteristics the base station sets a TDD or an FDD mode for communications." (See Office Action page 3). However, Claim

1 is directed to a mobile station analyzing a duplexing mode determination factor received from the base station to determine if the mobile station is located in a close area, and assigning a TDD channel to a forward link and a reverse link if the mobile station is located in a close area, and assigning a TDD channel to the forward link and an FDD channel to the reverse link to perform communication if the mobile station is located in a remote area. (See specification page 4, line 28-page 5, line 3).

As can be seen from this passage, there are several differences between the instant invention and the prior art of record. First, Claim 1 recites, “transmitting a duplexing mode determination factor to a base station” whereas Philip recites, “the microprocessor of the cellular telephone determines the characteristics of the service being requested.” The mobile station of the present invention transmits a duplexing mode as opposed to Philip’s microprocessor of the cellular telephone determining the characteristics of a service. Between transmitting and determining there is a world of difference. Second, Claim 1 recites, “setting a TDD mode or an FDD mode as a reverse mode” whereas Philip makes no mention of setting a reverse mode. Philip simply assigns whichever mode is available i.e. TDD or FDD, to the cellular system. (See page 10, lines 22-23). Furthermore, if neither FDD nor TDD is available, access to the system is denied to the cellular telephone. (See page 10, lines 21-22). In contrast, Claim 1 recites setting up a channel for the set reverse mode and a forward channel to perform communication. The Examiner is respectfully requested to point to the exact passage of Philip teaching this dual mode set-up disclosed by the present invention. The Examiner has failed to show that all of the recitations of Claim 1 are taught or suggested by Philip. Accordingly, the Examiner has failed to make out a prima facie case for an anticipation rejection.

Additionally, the present invention discloses transmitting/receiving, by a mobile station and a base station, a duplexing mode determination factor during call setup. Further, the base station receives the duplexing mode determination factor, and then sets the mode. However, Philip fails to teach the above features. Philip does not render independent Claim 1 unpatentable. Thus, independent Claim 1 is allowable in view of the above arguments.

As for independent Claims 24 and 25, the Examiner noted that the components listed in those claims are inherent. Applicants respectfully disagree. Applicants submit that before a reference can be found to disclose a feature by virtue of inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is *necessarily* present in the reference. Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) The test of inherency is not satisfied by what a reference “may” teach. *Id.* (“Inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient”.)


As for independent Claims 12 and 17, the same arguments set forth above regarding Claim 1 are equally applicable to Claims 12 and 17.

As for independent Claims 26 and 35, which are newly added, the same arguments set forth above regarding Claim 1 are equally applicable to these claims and consequently are believed to be in condition for allowance.

Accordingly, dependent Claims 2-11, 13-16, 18-23, 27-34 and 36 are allowable because of their dependence upon independent Claims 1, 12 and 17, 26 and 35 respectively.

Accordingly, all of the claims pending in the Application, namely, Claims 1-36 are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant’s attorney at the number given below.

Respectfully submitted,


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